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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/288,556 | 04/09/99 | KLEIN | J 44033-080 |

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HM12/0526

EXAMINER

CRIARES, T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1614

DATE MAILED:

05/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/288,556

Applicant(s)
KLEIN et al.

Examiner
First Last

Group Art Unit
1234



☒ Responsive to communication(s) filed on Apr 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) 2-20 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's election with traverse of the core moiety of "x" and "y" are N and "z" is C in Paper No. 6 is acknowledged. The traversal is on the ground(s) that a search of one species would overlap a search for all species. This is not found persuasive because the furyl, cyano sulfanyl groups cause the compounds to be classified in subclasses throughout class 514 and additional classes and have acquired a separate and distinct status in the art.

Claims 2-20 are withdrawn from prosecution.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

In view of the above the species as identified above has been searched.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Novick, Jr. (5,039,666).

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Novick, Jr. teaches in the Abstract and column 7, line 14 to column 8, line 13 compounds wherein tertiary hydroxyl groups are claimed and fall within applicants' generic claim 1. Formula XVI in column 8 is within the species as elected by applicant. Applicants claim is drawn to compounds with a proviso that excludes ω -1 secondary alcohol. However, the reference teaches alcohols which are not within this exclusion. The alcohols taught therein, as stated above are tertiary alcohols.


For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

None of the claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.J. Criares whose telephone number is (703) 308-4607. The examiner can normally be reached on Monday -Thursday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, Marianne Cintinis, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-7924.

May 15, 2000


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200
1600